THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today

- (1) was not written for publication in a law journal and
- (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES SKINNER, JOHN S. THORN,
CRAIG NORDBY and JOSEPH G. MERCINKIEWICZ

Appeal No. 1997-1359 Application 08/250,286¹

ON BRIEF

Before KRASS, JERRY SMITH and BARRY, <u>Administrative Patent</u> <u>Judges</u>.

JERRY SMITH, Administrative Patent Judge.

¹ Application for patent filed May 27, 1994.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 21-34, which constitute all the claims remaining in the application. An amendment after final rejection was filed on May 8, 1996 but was denied entry by the examiner.

The disclosed invention pertains to a method and apparatus for controlling the operation of a dynamoelectric machine adapted for use in an appliance. More specifically, the disclosed invention relates to the control of the machine using a microcontroller having memory means. The operating characteristics of the machine can be adjusted based on data entered by a user through a switch means after the machine has been installed in the appliance.

Representative claim 21 is reproduced as follows:

21. Drive apparatus for use with a dynamoelectric machine, comprising:

drive means connected to the dynamoelectric machine to control at least one of the current or voltage of the machine;

processor means including a microcontroller for supplying machine control information to the drive means, said processor means including first memory means and program means in said first memory means, said program means including a read only memory containing at least a portion of an operating program for operating the machine;

second memory means operatively associated with said processor means, said second memory means including a non-volatile memory;

switch means connected to said processor means, setting of said switch means selecting operational characteristic information from either of said first and said second memory means; and

programming means operatively attachable to said processor means for loading machine information into said processor means.

The examiner relies on the following references:

Toyoshima et al. (Toyoshima) Re. 34,286 June 22, 1993

The admitted prior art of appellants' specification.

Claims 21-34 stand rejected under 35 U.S.C. \S 103 2 . As evidence of obviousness the examiner offers Toyoshima in view of the admitted prior art.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence

 $^{^2}$ We note that claims 24 and 25 depend from cancelled claim 20. For purposes of this decision, since these claims are not separately argued, we have considered them as being dependent on independent claim 21.

of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 21-34. Accordingly, we affirm.

At the outset, we note that appellants have asked us to decide whether the examiner properly objected to the drawings under 37 CFR § 1.83(a) and whether the examiner properly denied entry of the amendment filed after the final rejection [brief, page 3]. The examiner responds that these issues are not appealable and must be challenged by petition to the Commissioner [answer, page 5]. The examiner is definitely correct on this point. Our jurisdiction is limited to the consideration of the propriety of rejections of the claims. It is not within our purview to consider objections to the drawings or the nonentry of amendments filed after final rejection. Therefore, we will have no further comment on these issues raised by appellants.

We now consider the rejection of the claims under 35 U.S.C. § 103. As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. <u>In re Oetiker</u>, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); <u>In re Piasecki</u>, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and <u>In re Rinehart</u>, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to each of independent claims 21, 26, 30 and 32, the examiner has pointed out the teachings of Toyoshima and the admitted prior art, has pointed out the perceived differences between this prior art and the claimed invention, and has reasonably indicated how and why Toyoshima and the admitted prior art would have been modified and/or combined to arrive at the

claimed invention. In our view, the examiner's analysis is sufficiently reasonable that we find that the examiner has satisfied the burden of presenting a <u>prima facie</u> case of obviousness. That is, the examiner's analysis, if left unrebutted, would be sufficient to support a rejection under 35 U.S.C. § 103. The burden is, therefore, upon appellants to come forward with evidence or arguments which persuasively rebut the examiner's <u>prima facie</u> case of obviousness. Appellants have presented several substantive arguments in response to the examiner's rejection. Therefore, we consider obviousness based upon the totality of the evidence and the relative persuasiveness of the arguments.

With respect to each of the independent claims, the main point of contention between appellants and the examiner concerns claim interpretation and whether Toyoshima teaches the invention as claimed. More specifically, each of the independent claims recites a switching means wherein the setting of the switch means selects operational characteristics of the device. Toyoshima teaches a vacuum cleaner in which a desired operation control rule is selected by a user by way of switches or memory cards. The examiner considers this operation to meet the recitation of selecting or altering the operational characteristics of the device.

Appellants argue that the key difference between the claimed invention and the Toyoshima device is that there is a "distinction between programming the switches to perform different functions, which is the essence of applicants' invention, and using the switches to select different values of the same function, which is what is shown by the Toyoshima reference" [brief, page 6].

We note that none of the independent claims recite switches to perform different functions (whatever that may mean) or switches to select different values of the same function. As noted above, the claims only recite that the operational characteristics of the device are selected or changed based on information entered by a user through switches. We have considered appellants' specification, and we can find no specific definition of "operational characteristic information" or "operating characteristics."

Claims are to be given their broadest reasonable interpretation during prosecution. <u>In re Zletz</u>, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); <u>In re Prater</u>, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). It is improper to narrow the scope of the claim by implicitly reading in disclosed limitations from the specification which have no express basis in the claims. <u>See Id</u>. In our view, the

examiner's interpretation of the claim language is consistent with this rule of claim interpretation whereas appellants' interpretation requires that limitations from the specification be read into the claims.

Where an inventor chooses to be his own lexicographer and to give terms uncommon meanings, he must set out his uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change.

Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1388, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992). As we noted above, the definition proposed by appellants for "operating characteristic information" or "operating characteristics" would not be apparent to the artisan who had only the application disclosure before him.

We also note that Toyoshima specifically states that "a cleaner having various kinds of operating characteristics can be easily realized" [column 12, lines 24-25, emphasis added]. Thus, Toyoshima certainly believes that his invention selects or adjusts "operating characteristics" of a dynamoelectric machine. We see no reason on this record why the operating characteristics of the claims should be considered as being different from the operating characteristics of Toyoshima. We will not read

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limitations into the claims in order to remove an applicable prior art reference.

For all the reasons noted above, we agree with the examiner that Toyoshima teaches the selection or adjustment of the operating characteristics of a dynamoelectric machine based on data entered through switches. The programming means of independent claim 21 is clearly met by the detachable external memory 43 of Toyoshima. The downloading of program information in independent claim 30 is also met by the downloading of information from external memory 43 of Toyoshima. The external memories 43a-43d of Toyoshima also serve to permit the Toyoshima cleaner to have its characteristics altered after the motor has been installed into the appliance.

In summary, all of appellants' arguments have been carefully considered, but we are not persuaded by any of the arguments that the rejection as formulated by the examiner is improper. Therefore, the decision of the examiner rejecting claims 21-34 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR \$ 1.136(a).

<u>AFFIRMED</u>

Errol A. Krass Administrative Patent Judge)))
Jerry Smith)) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
Lance Leonard Barry Administrative Patent Judge)

JS/dm

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